



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/727,105	04/25/85	SCHALLY	KIRKS, 0-101

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EXAMINER	
PHILLIPS, D	
ART UNIT	PAPER NUMBER
153	4

DATE MAILED: 05/15/86

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 4/21/86 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449 | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1, 3, 5-7, 9-15 + 18-21 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1, 3, 5-7, 9-15 + 18-21 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. These drawings are ☐ acceptable;
☐ not acceptable (see explanation).

10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received

☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

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The specification is objectionable under 35 U.S.C. 132 as introducing new matter in the change on page 3, line 29 from "can be used" to "may be useful". This changes the meaning of this phrase from positive to tentative. This change therefore would be introducing new matter.

The specification is still objectionable under 35 U.S.C. 101 and 112, first paragraph as reciting that the compounds are effective for treatment of cancer. As was admitted by applicant, this utility requires much more proof than is in the specification. It would appear the only method of overcoming this objection is cancellation of the material from the specification.

Claims 18 and 19 are again rejected under 35 U.S.C. 112, second paragraph as being incomplete claims in not defining the use of the composition. In order to be complete, a pharmaceutical composition claim must recite the use, otherwise it is considered to be unpatentable over the compound claim from which it depends.

Claims 1, 3, 5-7, 9-15 and 18-21 are rejected under 35 U.S.C. 103 as being obvious over the Sarantakis patents (904) and (394) and the Bauer et al. patents of record by the Examiner and applicants. As was pointed out in the last Office action, the Sarantakis patent shows larger peptides which have the same amino acid contents between the cysteine moieties. The Bauer et al. patents show peptides that have a shorter chain that have the same activity as the Sarantakis references. In fact in the generic disclosures the patents define peptides that would

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fit within the instant generic claims. It would therefore be obvious to one of ordinary skill in the art to expect activity from the shortening of the chains of the Sarantakis patents since such activity is taught by the Bauer et al. patents.

Applicant's amendment necessitated the new grounds of rejection. Accordingly, THIS ACTION IS MADE FINAL. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE OF THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Applicant is advised that this application and the art to which this application pertains has been transferred to another group. All further papers submitted in this application should carry the following items:

Serial No. 727,105

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1. Serial Number (checked for accuracy).
2. Group Art Unit 153.
3. Name of Examiner now in charge of this application D. R. Phillips.
4. Filing date.

DRPhillips:cdc

(703) 557-6525

5-8-86

Delbert R. Phillips
DELBERT R. PHILLIPS
PRIMARY EXAMINER
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